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REMARKS

Claims 1-65 are pending in the present Application. The pending claims have been presented for the Examiner's convenience. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Objections

Claims 13-65 stand objected to as being dependent upon a rejected base claim. Applicants wish to thank the Examiner for her indication that these claims would be allowable if rewritten in independent form. Applicants believe that all the claims are allowable as written. Reasons supporting this belief can be found below in response to the Examiner's rejection under 35 U.S.C. § 102(b).

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-12 stand rejected under 35 U.S.C. § 102(b), as allegedly unpatentable over U.S. Patent No. 4,910,288 to Dellacoletta. In particular the Examiner has acknowledged that Dellacoletta does not teach the instantly claimed glass transition temperature, volatile species concentration, the reactive end group concentration, or the weight average molecular weight of the polyimide sulfone. Despite the reference's failure to teach these claim limitations the Examiner has asserted "Given that Dellacoletta discloses a polyetherimide as instantly claimed prepared from reactants inclusive of those claimed; the position is taken that the polyetherimide of Dellacoletta would inherently possess said properties or characteristics since both are of the same structural identity." (Office Action, page 3) Applicants respectfully disagree with the rejection.

The properties and characteristics of polyimides in general and polyimide sulfones in particular can be significantly affected by the method of making them. As described in the instant specification, the reactive end group content in the final polyimide sulfone can be controlled during polyimide sulfone synthesis. Dellacoletta's teaching with regard to the synthesis of polyetherimide sulfone can be found at Col. 3, lines 41 to Col. 10, line 10 and in the Examples. Dellacoletta teaches that the dianhydride and the diamine should be prereacted

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prior to the addition of a capping agent. Once the capping agent is added and reacted to form a pre-polymer the prepolymer is further reacted to form a polyetherimide. Interestingly, Dellacoletta does not teach or suggest several key aspects of the process that are required to produce the polyimide sulfone claimed in the pending application. Notably, Dellacoletta does not teach or suggest analyzing the reaction product for residual amine or anhydride end groups or the addition of additional monomer or capping agent to keep the total amine and anhydride end group concentration below 120 meq/kg of resin, as is instantly claimed.

In order to support an anticipation rejection based on inherency, an Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one).

Applicants believe that there is insufficient information in Dellacoletta for the allegedly inherent features to necessarily flow from the teachings of Dellacoletta. Dellacoletta does not teach to how to obtain the instantly claimed polyimide sulfone, in particular one with a total reactive end group less than 120 milliequivalents/kilogram resin because Dellacoletta does not teach monitoring the amount of reactive end groups or how to adjust the amount of reactive end groups. As such the instantly claimed polyimide sulfone cannot be anticipated by Dellacoletta. Accordingly, Applicants respectfully request withdrawal of the rejection.

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It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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